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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/216,206	12/18/1998	DAVID WILLIAM ROTH	B2745.0025/P0025	1079

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BEH INVESTMENTS LLC  
1652 48TH STREET  
BROOKLYN, NY 11204

EXAMINER
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VAN BRAMER, JOHN W

ART UNIT	PAPER NUMBER
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3622

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06/17/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 09/216,206	<b>Applicant(s)</b> ROTH ET AL.	
	<b>Examiner</b> JOHN VAN BRAMER	<b>Art Unit</b> 3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 23 March 2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 49,50,62-96,112-148,164-200,216-227,231-269,271 and 272 is/are pending in the application.
- 4a) Of the above claim(s) 233-269,271 and 272 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 49,50,62-96,112-148,164-200,216-227,231 and 232 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 233-269,271 and 272 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on March 27, 2009 has been entered.

### ***Election/Restrictions***

2. Newly submitted claims 233-272 directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: Independent claims 49 and 166 are directed to determining an advertisement to serve to a viewer utilizing a browser wherein the advertisement is selected from a plurality advertisements associated with bids that have been submitted. Independent claims 62 and 114 are directed towards determining which advertisement of a plurality of advertisement to provide to a browser in response to an advertising opportunity wherein the computer system has a plurality of sets of bidding parameters that are associated with one or more advertisements, bids are submitted based upon the bidding parameters, the computer system selects the bid, identifies the advertisement, and serves the advertisement. Newly submitted independent claim 233, 271 and 272, and by virtue of dependency claims 234-270 represent a subcombination usable together with

independent claims 49 and 166 which have already received an action on the merits. Independent claims 49 and 166 determine which bids have been presented for selection and the select the winning bid. Independent claims 233, 271 and 272 are directed towards the actual generation of bids, which can be then used to operate the claimed invention disclosed in independent claims 49 and 166. Newly submitted independent claims 233, 271, and 272, and by virtue of dependency claims 234-270 represent a subcombination of the combination represented by independent claims 62 and 114. Independent claims utilize bidding parameters to determine whether or not to submit a bid and then submitting the bids and selecting the winning bid. Independent claims 233, 271, and 272 are directed towards generating bids and selecting bids after an indication of an advertising opportunity occurs but do not require that there be a plurality of bidding parameters maintained in the computer system prior to the advertising opportunity occurring. Furthermore, the bids claimed in 233, 271, and 272 may actually require the generation of a bid and do not merely selected from a set of bidding parameters already present. As newly submitted claims 233-272 are restricted by original presentation. .

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. The examiner notes that the applicant cancelled claim 270 in the preliminary amendment filed on March 27, 2009. Accordingly, claims 233-269, 271, and 272 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

***Priority***

3. The original application was filed on December 18, 1998 and listed the inventors as Heidi Kay of Berkeley, Ca; and Russell Fradin, of San Francisco, CA. The Declaration by said inventors attested that there was no claim of foreign priority and no claim of priority based on previously filed U.S. applications. The Assignee of the invention on December 18, 1998, was Flycast Communications Corporation of San Francisco, CA. According to the Specification filed December 18, 1998, the invention is an improvement over Application Serial Number 08/787,979, now Patent Number 6,285,987 which is assigned to the same assignee as the present invention and incorporated by reference into the present application(Specification: Page 5, lines 10-13). The Specification further discloses that the present invention is an improvement over the '987 patent because with the '987 patent "each advertiser provides one or more 'proposed bids' which specify how much the advertiser is willing to pay for displaying a particular advertisement in response to a view-op with certain characteristics. Each proposed bid specifies a price or amount that the advertiser is willing to pay for the opportunity to display an advertisement to a viewer who has a particular set of characteristics and on a web site and web page that meets a particular set of criteria. Each proposed bid can be dependent upon or require satisfaction of various criteria that must be met in order for a bid of a particular amount to be submitted" (Specification: Page 3, lines 14-22). The Specification further discloses that in the '987 patent "when a view-op arises, the system evaluates the characteristics of the view-op compared to the specifications of proposed bids. Next, the bid selection logic selects the highest bid

from the various available bids and the advertisement that has the highest bid for the particular view-op is displayed" (Specification Page 4, lines 9-12). The Specification indicates that the improvement over the '987 patent is that "when a view-op occurs which meets the specification in a bid, the view-op is further evaluated in terms of the comparative effectiveness of the particular advertisements on each of the sites on which the advertisement was previously displayed" (Specification: Page 4, lines 18-22). An Appeal Brief was filed on April 3, 2002 indicating that the Real Parties of interest was Engage, Inc. which is the assignee of Flycast Communications Inc.. The Appeal Brief argues that the previous examiners rejection of the claimed invention as being taught by the combined inventions of Hanson (U.S. Patent Number: 5,974,398) in view of Gerace (U.S. Patent Number: 5,991,735) under 35 U.S.C. 103(a). The arguments were related only to the rejection of the claims on their merits and no indication of changes to inventorship or priority date was mentioned. The Board Decision issued on July 22, 2003 affirmed the examiners rejection of all of the claims on appeal.

On July 23, 2003 the applicant filed a statement under 37 CFR 3.73(b) a chain of title from the inventors (Heidi Kay et al.), of the present invention to Flycast Communications Corp., from Flycast Communication Corp to Engage Technologies, from Engage Technologies (AKA Engage Inc.) to BEH Investments LLC.

On September 22, 2003, the applicant filed a Request for Continued Examination.

On January 22, 2004, the applicant filed a substitute specification claiming that, rather than an incorporation by reference as indicated in the Original Specification, the

present application is a continuation in part of co-pending application 08/787,979 (now the '987 patent). In the Office Actions issued on February 2, 2004 and March 22, 2004, the previous examiner did not explicitly enter the amendments to the specification.

According to MPEP 201.08, an alleged continuation-in-part application should be permitted to claim the benefit of an earlier non-provisional application if the alleged continuation-in-part complies with the other requirements of 35 USC 120 and 37 CFR 1.78 such as:

- a. The first application and the alleged continuation-in-part application were filed with at least one common inventor. In the instant case, as of the date of the filing of the specification claiming a continuation-in-part the present application and the 08/787,979 application (now the '987 patent) did not share a common inventor.
- b. The alleged continuation-in-part application was filed before the patenting or abandonment of or the termination of proceedings on the first application or an application similarly entitled to the benefit of the filing date of the first application. In the instant case, 08/787,979 application was issued as a patent on September 4, 2001 and the allegation of continuation-in-part for the present application was not attempted to be claimed until January 22, 2004.

On September 22, 2004, a new Declaration was filed signed in the inventor signature section is the name Benzion A. Wachsman for both the first and second inventor indicating that he is signing for the Assignee, and not the claimed inventors themselves. Along with the Declaration is a statement by the Assignee stating that Benzion A. Wachsman, is the President of BEH Investments LC and that he is

authorized on behalf of BEH to sign documents and that he consents to the request to change inventorship. Mr. Benzion A. Wachsman signed the Declaration because the inventors are unavailable or unwilling to sign the declaration after diligent effort by BEH. The Declaration indicates that the filing is necessary to preserve the rights of BEH Investments LLC with respect to the invention.

On September 22, 2004, a Petition was entered indicating a Request for Continued Examination and that upon review of currently pending claims 29-39, 41-50, and 54-61 that it was determined that the inventive entity set forth in the originally-filed declaration is in error. However, none of the currently pending claims were present when the originally filed declaration and claims were filed. The originally filed claims were Claims 1-13. Thus the examiner is confused as to how claims added during prosecution could provide an indication of inventorship in the original filing was in error. The petition indicated a diligent effort to contact Heidi Kay, Russell Fradin, David William Roth, and Dylan Salisbury and included copies of the letter sent to each. The letter indicated that the current owner (BEH Investments LLC) filed a continuation with additional claims. However, a continuation has not been filed in the case, instead a Request for Continued examination has been filed. A new Declaration was also filed including the names of Heidi Kay, Russell Fradin, David William Roth, and Dylan Salisbury but no signatures are provided on the Declaration.

On February 1, 2005 the petition was dismissed by the United States Patent and Trademark Office. The decision was based upon 37 CFR 1.48(a)(2) and 1.48(a)(3), which require that a statement from each person being added as an inventor and from

each person being deleted as an inventor that error in inventorship occurred without deceptive intention on his or her part and that a correct executed oath/dec be submitted. On August 1, 2005 a new petition was filed indicating that the two inventors being added are the only actual inventors (David William Roth and Dylan Fyall Salisbury) and that Mr. Salisbury has been successfully reached. The petition indicates numerous attempts to reach Mr. Roth but with no success. However, no further attempts were indicated as being attempted with regard to the only two inventors which are being deleted (Heidi Kay, Russell Fradin).

On September 25, 2005, the United States Patent and Trademark Office, granted the petition under 37 CFR 1.48(b) to remove Inventors Kay and Fradin from the application. 37 CFR 1.48(b) allows for the removal of inventors when amendments or cancellation of claims creates a situation in which the inventor's invention is no longer being claimed. The petitions under 37 CFR 1.48(c), 37 CFR 1.183 were dismissed because the Office did not receive the signed declaration by Mr. Salisbury.

On October 14, 2005 a petition was filed requesting a reconsideration of the previous petition and included a signed declaration by Mr. Salisbury.

On October 25, 2005, the United States Patent and Trademark Office dismissed the petition filed on October 14, 2005 because the declaration did not include a mailing address or residential address for inventor Roth, and a statement of lack of deceptive intent was not received and signed by Mr. Salisbury.

On January 19, 2006, a petition was filed requesting a reconsideration of the previous petition and included a proper declaration and statement of lack of deceptive intent.

On March 13, 2006, the petitions under 37 CFR 1.48(c) and 37 CFR 1.183 were granted by the United States Patent and Trademark Office. As a result the original inventors Heidi Kay and Russell Fradin were removed from the invention and David William Roth and Dylan Fyall Salisbury have become the inventors of record.

On November 24, 2006 a petition under 37 CFR 1.183 for suspension of the Patent Rules of the Code of Federal Regulations requesting suspension of 1.32, 3.71, and 3.73 which relate to "Power of attorney", "Prosecution by assignee" and "Establishing the right of assignee to take action" respectively. The Petition was requested a result of errors in the assignments, failure of Assignee to record certain assignment with the USPTO, and failure of Assignee to file correct statements under 3.73(b) may have resulted in incompliance with patent rules.

On June 13, 2007, the United States Patent and Trademark Office granted the petition under 37 CFR 1.183 and directed the Office to treat all papers filed prior to November 24, 2006, as being properly signed.

4. In light of the above prosecution history, and adhering to the petition decisions from the United States Patent and Trademark Office, the examiner must conclude that Original claims 1-13 filed in the application represented inventions of Heidi Kay, Russell Fradin and included no right to claim to priority to Application Serial Number

08/787,979, now Patent Number 6,285,987 because there was no inventor in common between the two applications. As such, the originally application filed on December 18, 1998 incorporated by reference the invention of Roth and Salisbury. On September 22, 2003, new claim 29 was added. This is the first time that, as supported by the petition filed on September 22, 2004, that a claim representing an invention for which Kay and Fradin lack inventorship rights to. As such, claim 29, according to the Petition filed on September 22, 2004 represented an invention for which Roth and Salisbury are solely responsible. On January 22, 2004 a substitute specification was filed which indicated that the present invention is a continuation in part of Application Serial Number 08/787,979, now Patent Number 6,285,987. According to MPEP 201.08, an alleged continuation-in-part application should be permitted to claim the benefit of an earlier non-provisional application if the alleged continuation-in-part complies with the other requirements of 35 USC 120 and 37 CFR 1.78. The first step in determining compliance requires common inventorship. The earliest date at which it would be possible to make a continuation-in-part claim in the present invention is the date at which claim 29 was added for prosecution because a continuation-in-part claim requires at least one common inventor between the two applications. Thus, it would not have been possible to claim a continuation-in-part status in the application prior to September 22, 2003. The next step in determining compliance requires that the alleged continuation-in-part application was filed before the patenting or abandonment of or the termination of proceedings on the first application or an application similarly entitled to the benefit of the filing date of the first application. In the instant case, 08/787,979

application was issued as a patent on September 4, 2001 and the allegation of continuation-in-part for the present application was not possible prior to September 22, 2003, two years after the patent was granted on the 08/787,979 application. Thus the examiner is unable to grant continuation-in-part status to the present invention. The effective filing date, for the purpose of prosecution is December 18, 1998.

### ***Specification***

5. The substitute specifications filed January 22, 2004 and March 5, 2007 have not been entered because it does not conform to 37 CFR 1.125(a) because: The nature of the amendments renders it difficult to consider the application. On January 22, 2004 and March 5, 2007 the applicant filed a substitute specification claiming that, rather than an incorporation by reference as indicated in the Original Specification, the present application is a continuation in part of co-pending application 08/787,979 (now the '987 patent). The original invention was submitted by two inventors, Heidi Kay and Russell Fradin. As neither of these inventors are in common with the inventors of co-pending application 08/787,979, the originally filed invention was not eligible for claiming continuation-in-part status. During prosecution, the cancellation and/or amendments to the claims required the removal of Heidi Kay and Russell Fradin as inventors and the addition of David William Roth and Dylan Fyall Salisbury. This change occurred on or about the time at which claims 1-13 were cancelled and/or claims 29-39, 41-50, and 54-61. Claim 29 was added on September 22, 2003. Since Mr. Roth and Salisbury are the inventors of application 08/787,979, the ability to claim continuation-in-part status did

not occur until at least September 22, 2003. However, application 08/787,979 was issued for patent on September 4, 2001, nearly two years prior when the present application was eligible for continuation in part status. Since the present application and the 08/787,979 application were not eligible for claiming continuation-in-part status during the copendency of the applications, and the ability to claim continuation-in-part status only occurred two years after the 08/787,979 application had already issued for patent the amendment to the Specification fails to satisfy the requirements of MPEP 201.08. As such, the amendments are not entered.

### ***Response to Amendment***

6. The amendment filed on March 23, 2009 cancelled claims 97-111, 149-163, and 201-215 and amended claims 62, 114, and 166. New claims 233-270 were added. The amendment filed on March 27, 2009, cancelled claims 228-230 and 270. Claims 49, 62, 114, 166, and 235 were amended and new claims 271 and 272 were added. Thus the currently pending claims in the application are claims 49, 50, 62-96, 112-148, 164-200, 216-227, 231-269, 271, and 272 of which claims 233-269, 271 and 272 have been withdrawn based upon restriction by original presentation. Thus the currently pending claims addressed below are claims 49, 50, 62-96, 112-148, 164-200 and 216-227, 231, 232.

### ***Claim Rejections - 35 USC § 102***

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7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 49,50, 62-66, 114-118, 166-170, 218, 219, 226, 227, 231 and 232 are rejected under 35 U.S.C. 102(b) as being anticipated by Yager (Ronald R. Yager, “Intelligent Agents for World Wide Web Advertising Decisions”, International Journal of Intelligent Systems, Vol. 12, pp. 379-390, 1997).

Claim 49: Yager discloses a computerized method for determining an advertisement in response to an advertising opportunity, wherein the advertising opportunity is an opportunity to place the advertisement on a web page subsequent to a request for the web page by a viewer utilizing a browser, the computerized method comprising:

- a. Receiving in a computer network an indication of the advertising opportunity.

(Page 383, Paragraph 2)

- b. In response to receiving the indication: selecting in a computer system the advertisement from among a plurality of advertisements associated with bids submitted in real-time by the computer on behalf of advertisers desiring to fulfill the advertising opportunity wherein the computer system is embodied with computer instructions for implementing the computerized method. (Page 383, Paragraph 2)

Claim 50: Yager discloses the method of claim 49, wherein the indication of the advertising opportunity is initiated by the browser sending a reference in the web page. (Page 382, Paragraph 6)

Claim 218: Yager discloses the method of claim 49, wherein each bidding advertiser is associated with a bid, the bid being associated with indicating a monetary amount the each bidding advertiser is willing to pay if an advertisement associated with each bidding advertiser is selected and a specific event occurs. (Page 382, Paragraph 3)

Claims 62: Yager discloses a method implemented in a computer system, comprising one or more networked computers, for determining in response to each advertising opportunity of a plurality of advertising opportunities, which advertisement of a plurality of advertisements to provide for fulfilling the each advertising opportunity, the each advertising opportunity being an opportunity to serve an advertisement to a browser in response to a request for content by the browser, the method comprising:

- a. Maintaining in the computer system a plurality of sets of bidding parameters, each set of bidding parameters being associated with one or more of the plurality of advertisements and an advertiser, and indicating whether the associated advertiser is desirous that a bid should be submitted for providing one of the associated one or more of the plurality of advertisements for fulfilling the each

advertising opportunity and an amount associated with such bid if to be submitted. (Page 384, Paragraph 1)

- b. Receiving in the computer system an indication of the request for content, thereby presenting the each advertising opportunity. (Page 383, Paragraph 2)
- c. In response to the request for content: submitting in the computer system one or more bids, each submitted bid being based on one of the sets of bidding parameters, the one of the sets of bidding parameters being met by characteristics of the advertising opportunity, wherein the each submitted bid, in accordance with the one of the sets of bidding parameters, is associated with a monetary amount that an advertiser associated with the each submitted bid is willing to pay if the each submitted bid is selected and a specific event occurs. (Page 383, Paragraph 2 through Paragraph 3)
- d. Selecting in the computer system a bid from among the submitted bids. (Page 384, Paragraph 1)
- e. Identifying in the computer system an advertisement associated with the selected bid. (Page 384, Paragraph 1)
- f. Serving with the computer system the identified advertisement in real time response to the request for the content, wherein the computer system is embodied with computer instructions for implementing the method. (Page 384, Paragraph 1)

Claim 114. Yager discloses a computer system for determining in response to each advertising opportunity of a plurality of advertising opportunities, which advertisement of a plurality of advertisements to provide for fulfilling the each advertising opportunity, wherein the each advertising opportunity is an opportunity to serve an advertisement to a browser in response to a request for content by the browser, the system comprising:

- a. A computer system comprising one or more networked computers, the one or more networked computers embodied with computer instruction that:
  - i. Maintains the plurality of advertisements and a plurality of sets of bidding parameters, each set of bidding parameters being associated with one or more of the plurality of advertisements and an advertiser, and indicating whether the associated advertiser is desirous that a bid should be submitted for providing one of the associated one or more of the plurality of advertisements for fulfilling the each advertising opportunity and an amount associated with such bid if to be submitted. (Page 383, Paragraph 2; Page 384, Paragraph 1; and Page 387, Paragraph 3)
  - ii. Receives an indication of the request for content, thereby presenting the each advertising opportunity. (Page 383, Paragraph 2)
  - iii. Submits in response to the request for content, one or more bids, wherein each submitted bid is based on one of the sets of bidding parameters, wherein the one of the sets of bidding parameters is met by characteristics of the advertising opportunity, wherein the each submitted bid, in accordance

- with the one of the sets of bidding parameters, is associated with a monetary amount that an advertiser associated with the each submitted bid is willing to pay if the each submitted bid is selected and a specific event occurs. (Page 383, Paragraph 2 through Paragraph 3)
- v. Selects a bid from among the submitted bids. (Page 384, Paragraph 1)
  - vi. Identifies an advertisement associated with the selected bid, whereby the system determines the identified advertisement by a bidding process. (Page 386, Paragraph 3; and Page 389, Paragraph 1 through 3)
  - vi. Serves the identified advertisement in real time response to the request for content. (Page 384, Paragraph 1)

Claims 226 and 227: Yager discloses the method of claims 62 and 114 respectively, wherein information about a viewer utilizing the browser is stored in the computer system. (Page 380, Paragraph 2)

Claim 166. Yager discloses a method implemented in a computer system comprising one or more networked computers, for determining in response to each advertising opportunity of a plurality of advertising opportunities, which advertisement of a plurality of advertisements to provide for fulfilling the advertising opportunity, the each advertising opportunity being an opportunity to serve an advertisement to a browser, the method comprising:

- a. Receiving in the computer system an indication of the each advertising opportunity. (Page 383, Paragraph 2, and Page 384, Paragraph 1)
- b. In real time response to the indication: determining in the computer system one or more bids, each determined bid being associated with a monetary amount an advertiser associated with the each determined bid is willing to pay for the each determined bid is willing to pay for the each determined bid to be selected and a specific event to occur. (Page 383, Paragraph 2 through Paragraph 3)
- c. Selecting in the computer system a bid from among the determined bids. (Page 383, Paragraph 2 through Page 384, Paragraph 1)
- d. Identifying in the computer system one of the plurality of advertisements associated with the selected bid. (Page 386, Paragraph 3; and Page 389, Paragraph 1 through 3)
- e. Serving the identified advertisement to the browser, whereby the identified advertisement is determined by a bidding process, wherein the computer system is embodied with computer instructions for implementing the method. (Page 384, Paragraph 1)

Claims 63, 115, and 167: Yager discloses the method of claims 62, 114, and 166 respectively, wherein the monetary amount associated with each of the submitted bids is included in the each of the submitted bids. (Page 383, Paragraph 2 through Paragraph 3)

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Claims 64, 116, and 168: Yager discloses the method of claims 62, 114, and 166 respectively, wherein the specific event for which the advertiser associated with each of the determined bids is willing to pay the monetary amount associated with the each of the submitted bids, is a same respective event for all of the submitted and determined bids. (Page 383, Paragraph 2 through Paragraph 3)

Claim 65, 117, 169, 219: Yager discloses the method of claims 62, 114, 166, and 218, wherein the specific event for which the advertiser associated with at least one of the submitted bids is willing to pay the monetary amount associated with the at least one of the submitted bids, is a serving of an advertisement associated with the at least one of the submitted bids to the browser in fulfillment of the each advertising opportunity. (Page 383, Paragraph 3)

Claims 66, 118, and 170: Yager discloses the method of claims 65, 117, and 169 respectively, wherein the specific event for which the advertiser associated with at least one determined bid is willing to pay the monetary amount associated with the at least one submitted and determined bid is a serving of an advertisement associated with the at least one submitted and determined bid to the browser in fulfillment of the each advertising opportunity. (Page 383, Paragraph 3)

Claims 231 and 232: Yager discloses the method and system of claims 62 and 114 respectively, wherein at least one of the plurality of sets of bidding parameters

includes a plurality of levels, wherein a first level includes a first criteria of advertising opportunity and a second level includes the first criteria of advertising opportunities and a second criteria of advertising opportunities. (Page 385, Paragraph 1 through Page 386, Paragraph 2)

9. Claims 49,50, 62-66, 114-118, 166-170, 218, 219, 226, 227, 231 and 232 are rejected under 35 U.S.C. 102(b) as being anticipated by Goldhaber et al. (U.S. Patent Number: 5,794,210).

Claim 49: Goldhaber discloses a computerized method for determining an advertisement in response to an advertising opportunity, wherein the advertising opportunity is an opportunity to place the advertisement on a web page subsequent to a request for the web page by a viewer utilizing a browser, the computerized method comprising:

- a. Receiving in a computer network an indication of the advertising opportunity. (Col 7, lines 27-47)
- b. In response to receiving the indication: selecting in a computer system the advertisement from among a plurality of advertisements associated with bids submitted in real-time by the computer on behalf of advertisers desiring to fulfill the advertising opportunity wherein the computer system is embodied with computer instructions for implementing the computerized method. (Col 4, lines 47-63; Col 7, lines 27-47; and Col 14, lines 12-46)

Claim 50: Goldhaber discloses the method of claim 49, wherein the indication of the advertising opportunity is initiated by the browser sending a reference in the web page. (Col 14, line 59 through Col 15, line 6)

Claim 218: Goldhaber discloses the method of claim 49, wherein each bidding advertiser is associated with a bid, the bid being associated with indicating a monetary amount the each bidding advertiser is willing to pay if an advertisement associated with each bidding advertiser is selected and a specific event occurs. (Col 4, lines 47-63; and Col 14, lines 12-46; and Col 17, lines 33-63)

Claims 62: Goldhaber discloses a method implemented in a computer system, comprising one or more networked computers, for determining in response to each advertising opportunity of a plurality of advertising opportunities, which advertisement of a plurality of advertisements to provide for fulfilling the each advertising opportunity, the each advertising opportunity being an opportunity to serve an advertisement to a browser in response to a request for content by the browser, the method comprising:

- a. Maintaining in the computer system a plurality of sets of bidding parameters, each set of bidding parameters being associated with one or more of the plurality of advertisements and an advertiser, and indicating whether the associated advertiser is desirous that a bid should be submitted for providing one of the

associated one or more of the plurality of advertisements for fulfilling the each advertising opportunity and an amount associated with such bid if to be submitted. (Col 4, lines 47-63; Col 7, lines 27-47; and Col 14, lines 12-46)

- b. Receiving in the computer system an indication of the request for content, thereby presenting the each advertising opportunity. (Col 4, lines 47-63; Col 7, lines 27-47; and Col 14, lines 12-46)
- c. In response to the request for content: submitting in the computer system one or more bids, each submitted bid being based on one of the sets of bidding parameters, the one of the sets of bidding parameters being met by characteristics of the advertising opportunity, wherein the each submitted bid, in accordance with the one of the sets of bidding parameters, is associated with a monetary amount that an advertiser associated with the each submitted bid is willing to pay if the each submitted bid is selected and a specific event occurs. (Col 4, lines 47-63; Col 7, lines 27-47; Col 14, lines 12-46; Col 14, line 59 through Col 15, line 6; and Col 17, lines 33-63)
- d. Selecting in the computer system a bid from among the submitted bids. (Col 4, lines 47-63)
- e. Identifying in the computer system an advertisement associated with the selected bid. (Col 4, lines 47-63; Col 7, lines 27-47; Col 14, lines 12-46; Col 14, line 59 through Col 15, line 6; and Col 17, lines 33-63)
- f. Serving with the computer system the identified advertisement in real time response to the request for the content, wherein the computer system is

embodied with computer instructions for implementing the method. (Col 4, lines 47-63; Col 7, lines 27-47; Col 14, lines 12-46; Col 14, line 59 through Col 15, line 6; and Col 17, lines 33-63)

Claim 114. Goldhaber discloses a computer system for determining in response to each advertising opportunity of a plurality of advertising opportunities, which advertisement of a plurality of advertisements to provide for fulfilling the each advertising opportunity, wherein the each advertising opportunity is an opportunity to serve an advertisement to a browser in response to a request for content by the browser, the system comprising:

- a. A computer system comprising one or more networked computers, the one or more networked computers embodied with computer instruction that:
  - i. Maintains the plurality of advertisements and a plurality of sets of bidding parameters, each set of bidding parameters being associated with one or more of the plurality of advertisements and an advertiser, and indicating whether the associated advertiser is desirous that a bid should be submitted for providing one of the associated one or more of the plurality of advertisements for fulfilling the each advertising opportunity and an amount associated with such bid if to be submitted. (Col 4, lines 47-63; Col 7, lines 27-47; and Col 14, lines 12-46)

- ii. Receives an indication of the request for content, thereby presenting the each advertising opportunity. (Col 4, lines 47-63; Col 7, lines 27-47; and Col 14, lines 12-46)
- iii. Submits in response to the request for content, one or more bids, wherein each submitted bid is based on one of the sets of bidding parameters, wherein the one of the sets of bidding parameters is met by characteristics of the advertising opportunity, wherein the each submitted bid, in accordance with the one of the sets of bidding parameters, is associated with a monetary amount that an advertiser associated with the each submitted bid is willing to pay if the each submitted bid is selected and a specific event occurs. (Col 4, lines 47-63; Col 7, lines 27-47; Col 14, lines 12-46; Col 14, line 59 through Col 15, line 6; and Col 17, lines 33-63)
- iv. Selects a bid from among the submitted bids. (Col 4, lines 47-63)
- v. Identifies an advertisement associated with the selected bid, whereby the system determines the identified advertisement by a bidding process. (Col 4, lines 47-63; Col 7, lines 27-47; Col 14, lines 12-46; Col 14, line 59 through Col 15, line 6; and Col 17, lines 33-63)
- vi. Serves the identified advertisement in real time response to the request for content. (Col 4, lines 47-63; Col 7, lines 27-47; Col 14, lines 12-46; Col 14, line 59 through Col 15, line 6; and Col 17, lines 33-63)

Claims 226 and 227: Goldhaber discloses the method of claims 62 and 114 respectively, wherein information about a viewer utilizing the browser is stored in the computer system. (Col 12, lines 14-37; Col 13, line 49 through Col 14, line 46; Col 15, lines 17-47; and Col 15, line 57 through Col 16, line 40)

Claim 166. Goldhaber discloses a method implemented in a computer system comprising one or more networked computers, for determining in response to each advertising opportunity of a plurality of advertising opportunities, which advertisement of a plurality of advertisements to provide for fulfilling the advertising opportunity, the each advertising opportunity being an opportunity to serve an advertisement to a browser, the method comprising:

- a. Receiving in the computer system an indication of the each advertising opportunity. (Col 4, lines 47-63; Col 7, lines 27-47; and Col 14, lines 12-46)
- b. In real time response to the indication: determining in the computer system one or more bids, each determined bid being associated with a monetary amount an advertiser associated with the each determined bid is willing to pay for the each determined bid is willing to pay for the each determined bid to be selected and a specific event to occur. (Col 4, lines 47-63; Col 7, lines 27-47; Col 14, lines 12-46; Col 14, line 59 through Col 15, line 6; and Col 17, lines 33-63)
- c. Selecting in the computer system a bid from among the determined bids. (Col 4, lines 47-63)

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- d. Identifying in the computer system one of the plurality of advertisements associated with the selected bid. (Col 4, lines 47-63; Col 7, lines 27-47; Col 14, lines 12-46; Col 14, line 59 through Col 15, line 6; and Col 17, lines 33-63)
- e. Serving the identified advertisement to the browser, whereby the identified advertisement is determined by a bidding process, wherein the computer system is embodied with computer instructions for implementing the method. (Col 4, lines 47-63; Col 7, lines 27-47; Col 14, lines 12-46; Col 14, line 59 through Col 15, line 6; and Col 17, lines 33-63)

Claims 63, 115, and 167: Goldhaber discloses the method of claims 62, 114, and 166 respectively, wherein the monetary amount associated with each of the submitted bids is included in the each of the submitted bids. (Col 4, lines 47-63; Col 7, lines 27-47; Col 14, lines 12-46; Col 14, line 59 through Col 15, line 6; and Col 17, lines 33-63)

Claims 64, 116, and 168: Goldhaber discloses the method of claims 62, 114, and 166 respectively, wherein the specific event for which the advertiser associated with each of the determined bids is willing to pay the monetary amount associated with the each of the submitted bids, is a same respective event for all of the submitted and determined bids. (Col 4, lines 47-63; Col 7, lines 27-47; and Col 14, lines 12-46)

Claim 65, 117, 169, 219: Goldhaber discloses the method of claims 62, 114, 166, and 218, wherein the specific event for which the advertiser associated with at least one of the submitted bids is willing to pay the monetary amount associated with the at least one of the submitted bids, is a serving of an advertisement associated with the at least one of the submitted bids to the browser in fulfillment of the each advertising opportunity. (Col 4, lines 47-63; Col 7, lines 27-47; Col 14, lines 12-46; Col 14, line 59 through Col 15, line 6; and Col 17, lines 33-63)

Claims 66, 118, and 170: Goldhaber discloses the method of claims 65, 117, and 169 respectively, wherein the specific event for which the advertiser associated with at least one determined bid is willing to pay the monetary amount associated with the at least one submitted and determined bid is a serving of an advertisement associated with the at least one submitted and determined bid to the browser in fulfillment of the each advertising opportunity. (Col 4, lines 47-63; Col 7, lines 27-47; Col 14, lines 12-46; Col 14, line 59 through Col 15, line 6; and Col 17, lines 33-63)

Claims 231 and 232: Goldhaber discloses the method and system of claims 62 and 114 respectively, wherein at least one of the plurality of sets of bidding parameters includes a plurality of levels, wherein a first level includes a first criteria of advertising opportunity and a second level includes the first criteria of advertising opportunities and a second criteria of advertising opportunities. (Col 4, lines 47-63; Col 7, lines 27-

47; Col 14, lines 12-46; Col 14, line 59 through Col 15, line 6; and Col 17, lines 33-63)

***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 67-96, 112, 113, 119-148, 164, 165, 171-200, 216, 217 and 220-225 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yager (Ronald R. Yager, "Intelligent Agents for World Wide Web Advertising Decisions", International Journal of Intelligent Systems, Vol. 12, pp. 379-390, 1997).

Claims 67, 70, 73, 76, 79, 119, 122, 125, 128, 131, 171, 174, 177, 180, and 183: Yager discloses the method of claims 62, 63, 64, 65, 66, 114, 115, 116, 117, 118, 166, 167, 168, 169, 170 respectively. Yager further discloses the user requesting content by the browser. (Page 383, Paragraph 6). Yager is silent with regard to the protocol used in transmitting the request from the browser, however it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the standard HTTP protocol for communicating between the website and the browser as well as provide indications using said protocol. The rationale for using the

standardized HTTP protocol in order to avoid the cost and expense of developing and distributing a customized transaction protocol to all potential customers is that the HTTP protocol is one of a limited number or predictable protocols used to transmit requests from browsers.

Claims 68, 71, 74, 77, 80, 120,123, 126, 129, 132, 172, 175, 178,181, and 184:

Yager discloses the method of claims 67, 70, 73, 76, 79, 119, 122, 125, 128, 131, 171, 174, 177, 180, and 183 respectively, wherein the advertisement served to the browser in response to the request for content is included in a webpage accessed by the browser. (Page 384, Paragraph 1)

Claims 69, 72, 75, 78, 81, 121, 124, 127, 130, 133, 173, 176, 179, 182, and 185:

Yager discloses the method of claims 68, 71, 74, 77, 80, 120, 123, 126, 129, 132, 172, 175, 178, 181, and 184 respectively, wherein the request for content by the browser is caused by a reference in the web page. (Page 384, Paragraph 1)

Claims 82-96, 134-148,186-200, 220, and 222: Yager discloses the method of claims 67-81, 119-133,171-185, 218, and 219 respectively, wherein the selection of the selected bid is based on the selected bid being associated with a highest monetary amount. (Page 386, Paragraph 3; and Page 389, Paragraph 1 through 3)

Claims 221 and 223: Yager discloses the method of claims 218 and 219 respectively, wherein the selection of the selected bid is based on the selected bid being determined in a computer system as having a highest beneficial value over respective beneficial values of other submitted bids. (Page 386, Paragraph 3; and Page 389, Paragraph 1 through 3)

Claims 112, 164, 216, and 224: Yager discloses the method of claims 62, 114, 185 and 218 respectively, wherein each submitted bid is associated with a respective bidding agent. (Page 383, Paragraph 2 through Paragraph 3; and Page 384, Paragraph 1)

Claim 113, 165, 217 and 225: Yager discloses the method of claims 62, 114, 185 and 218 respectively, wherein each submitted bid includes a reference to an advertisement associated with the each submitted bid. (Page 383, Paragraph 2 through Paragraph 3; and Page 384, Paragraph 1)

12. Claims 67-96, 112, 113, 119-148, 164, 165, 171-200, 216, 217 and 220-225 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goldhaber et al. (U.S. Patent Number: 5,794,210).

Claims 67, 70, 73, 76, 79, 119, 122, 125, 128, 131, 171, 174, 177, 180, and 183: Goldhaber discloses the method of claims 62, 63, 64, 65, 66, 114, 115, 116, 117,

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118, 166, 167, 168, 169, 170 respectively. Goldhaber further discloses the user logging onto a homepage and seeing ads that she may elect to view. (Col 7, lines 27-47). Goldhaber is silent with regard to the protocol used in transmitting the request from the browser, however it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the standard HTTP protocol for communicating between the website and the browser as well as provide indications using said protocol. The rationale for using the standardized HTTP protocol in order to avoid the cost and expense of developing and distributing a customized transaction protocol to all potential customers is that the HTTP protocol is one of a limited number or predictable protocols used to transmit requests from browsers.

Claims 68, 71, 74, 77, 80, 120, 123, 126, 129, 132, 172, 175, 178, 181, and 184: Goldhaber discloses the method of claims 67, 70, 73, 76, 79, 119, 122, 125, 128, 131, 171, 174, 177, 180, and 183 respectively, wherein the advertisement served to the browser in response to the request for content is included in a webpage accessed by the browser. (Col 4, lines 47-63; Col 7, lines 27-47; Col 14, lines 12-46; Col 14, line 59 through Col 15, line 6; and Col 17, lines 33-63)

Claims 69, 72, 75, 78, 81, 121, 124, 127, 130, 133, 173, 176, 179, 182, and 185: Goldhaber discloses the method of claims 68, 71, 74, 77, 80, 120, 123, 126, 129, 132, 172, 175, 178, 181, and 184 respectively, wherein the request for content by

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the browser is caused by a reference in the web page. (Col 4, lines 47-63; Col 7, lines 27-47; Col 14, lines 12-46; Col 14, line 59 through Col 15, line 6; and Col 17, lines 33-63)

Claims 82-96, 134-148, 186-200, 220, and 222: Goldhaber discloses the method of claims 67-81, 119-133, 171-185, 218, and 219 respectively, wherein the selection of the selected bid is based on the selected bid being associated with an auction process. (Col 4, lines 47-63; Col 7, lines 27-47; Col 14, lines 12-46; Col 14, line 59 through Col 15, line 6; and Col 17, lines 33-63) While Goldhaber does not explicitly state the winning bid is associated with highest monetary amount, it would have been obvious to one of ordinary skill in the art at the time of the invention to select the highest bid for the given targeting parameters as the winning bid in the auction process. The rationale for selecting the highest bid, is that there are a limited number of predictable processes used to select the winner of an auction process and one such predictable process is the selection of the highest bidder as the winner.

Claims 221 and 223: Goldhaber discloses the method of claims 218 and 219 respectively, wherein the selection of the selected bid is based on the selected bid being determined in a computer system through an auction process and including advertisement relevance or targeting criteria (Col 4, lines 47-63; Col 7, lines 27-47; Col 14, lines 12-46; Col 14, line 59 through Col 15, line 6; and Col 17, lines 33-63). While Goldhaber does not explicitly state the winning bid is associated with highest

beneficial value over respective beneficial values of other submitted bids, it would have been obvious to one of ordinary skill in the art at the time of the invention to select the highest beneficial for the given targeting parameters as the winning bid in the auction process. The rationale for selecting the highest beneficial value, is that there are a limited number of predictable processes used to select the winner of an auction process and one such predictable process is the selection of the bid that has the highest beneficial value.

Claims 112, 164, 216, and 224: Goldhaber discloses the method of claims 62, 114, 185 and 218 respectively, wherein each submitted bid is associated with a respective bidding agent. (Col 4, lines 47-63; Col 7, lines 27-47; Col 14, lines 12-46; Col 14, line 59 through Col 15, line 6; and Col 17, lines 33-63)

Claim 113, 165, 217 and 225: Goldhaber discloses the method of claims 62, 114, 185 and 218 respectively, wherein each submitted bid includes a reference to an advertisement associated with the each submitted bid. (Col 4, lines 47-63; Col 7, lines 27-47; Col 14, lines 12-46; Col 14, line 59 through Col 15, line 6; and Col 17, lines 33-63)

***Response to Arguments***

13. Applicant's arguments filed March 23, 2009 have been fully considered but they are not persuasive.
- a. The applicant argues that due to the applicants claim for priority to the '979 application, the application of the Yager art is not prior art. However, as explained in the Office Action above, the present application is not able to claim the '979 as a continuation-in-part and as such does not receive the priority filing date of the '979 application. In an effort to further the prosecution of the case the examiner has also added a prior art rejection based upon the Goldhaber reference which is prior art for both the present application as well as the '979 application.
- b. Based upon the applicants arguments the examiner has withdrawn the rejections based upon Roth preliminary Motion No. 2.

***Conclusion***

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to JOHN VAN BRAMER whose telephone number is (571)272-8198. The examiner can normally be reached on 6am - 4pm Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

John Van Bramer  
/John Van Bramer/  
Examiner, Art Unit 3622